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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2303

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on September 19, 2006

Signature

Typed or printed

name Richard A. Machonkin

Application Number

10/629,406

Filed

July 29, 2003

First Named Inventor

Bryce A. Jones

Art Unit

2617

Examiner

Keith Ferguson

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

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September 19, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Docket No. 2303)

In re Application of:)	
)	
Jones, et al.)	Art Unit: 2617
)	
Serial No.: 10/629,406)	
)	Examiner: Keith Ferguson
Filed: July 29, 2003)	
)	
For: Method and System for Determining)	Confirmation No. 7229
Availability of a Radio Network)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REASONS FOR REVIEW OF FINAL REJECTION

Applicants request review of the final rejection mailed July 5, 2006, because the Examiner has clearly erred in rejecting the claims under § 103(a).

1. The Claimed Invention

Applicants' claims are directed to methods and systems for determining that a mobile station has changed location and thereafter stopped moving as a trigger condition for performing a predetermined action (such as checking availability of a radio network). Independent claims 1, 14, and 20, each recite, in one way or another, the function of determining that the mobile station has changed location and thereafter stopped moving:

- Claim 1 recites "detecting that a mobile station communicating with a first radio network has changed location and thereafter stopped moving";

- Claim 14 recites “determining that a mobile station communicating with a wireless wide area network (WWAN) has changed location and thereafter stopped moving”; and
- Claim 20 recites “logic stored in the memory and executable on the processor to (i) determine that the mobile station has changed location and thereafter stopped moving.”

In addition, independent claims 1 and 20 recite the function of performing a predetermined action in response to the determination:

- Claim 1 recites “in response to detecting that the mobile station has changed location and thereafter stopped moving, performing a predetermined action, wherein the predetermined action comprises checking for availability of a wireless local area network (WLAN)”;
- Claim 14 recites “logic stored in the memory and executable on the processor to ... (ii) in response to determining that the mobile station has changed location and thereafter stopped moving, performing a predetermined action.”

2. Status of the Claims

Claims 1-10 and 12-24 are currently pending. All claims stand rejected under § 103(a) as being unpatentable over Mimura, U.S. Pub. No. 2002/0027891 (“Mimura”) in combination with one or more other references.

3. The Examiner’s Clear Error

a. Mimura does not teach determining that a mobile station has stopped moving

In rejecting independent claims 1, 14, and 20, the Examiner has asserted that Mimura teaches determining that a mobile station has changed location and thereafter stopped moving. In particular, the Examiner has argued that the mobile station moves from position I and stops at position II, citing to Figure 12 and paragraph 126 of Mimura. *See* Final Office Action, pp. 2, 8,

9, and 11. However, Figure 12 actually shows that the mobile station continues on to position III, as indicated by the dashed arrow from position II to position III. Thus, Figure 12 shows that position II is a point in transit for the mobile station, not a stopping point.

Moreover, nothing in paragraph 126 indicates that the mobile station actually stops at position II. To the contrary, paragraph 126 states that the reception level of the pilot channel from base station BS3 *increases* in the mobile station, which means that the mobile station is moving closer to base station BS3. Moreover, paragraph 126 does not state that the reception level stops increasing, which is what would happen if the mobile station actually stopped moving.

The Examiner has argued that the CPU of the mobile station waits for a predetermined amount of time for a handoff instruction. *See* Final Office Action, p. 11. However, that does not mean that the mobile station actually stops moving for a predetermined period of time. Obviously, whether a mobile station stops or moves will depend on the person or vehicle that is carrying the mobile station, not on the mobile station's CPU.

Accordingly, the Examiner's rejections of independent claims 1, 14, and 20 are clearly erroneous.

b. Mimura does not teach performing a predetermined action in response to determining that the mobile station has changed location and thereafter stopped moving

Even if Mimura were to be viewed as somehow teaching a determination that the mobile station has stopped moving, Mimura does not teach performing a predetermined action in response to such determination, as recited in independent claims 1 and 20.

In rejecting claim 1, the Examiner alleged that Mimura teaches (in paragraph 126) that the mobile station checks whether a handoff instruction is sent, in response to determining that

the mobile station has changed location and thereafter stopped moving.¹ However, paragraph 126 does not state that this check for a handoff instruction occurs in response to determining that the mobile station has stopped moving. What paragraph 126 actually states is that when the reception power of the pilot channel *exceeds the threshold* (the increasing reception power means that the mobile station is still moving, not stopped), the mobile station's CPU transmits a message and thereafter checks whether a handoff instruction is sent within a predetermined period of time.

Accordingly, the Examiner's rejections of independent claims 1 and 20 are clearly erroneous.

4. Conclusion

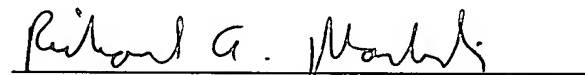
For the foregoing reasons, Applicants submit that all of the pending claims should be allowed.

Respectfully submitted,

**McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

Date: September 19, 2006

By:



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¹ The Examiner's rationale for rejecting claim 20 is deficient on its face because it does not identify any predetermined action that is performed in response to determining that the mobile station has *stopped moving*. The Examiner has alleged only that a predetermined action (registering with a new network) is performed in response to determining that the mobile station has *changed location*. See Final Office Action, p. 9.